

REMARKS-General

The newly drafted independent claim 27 incorporates all structural limitations of the original claim 1 and includes further limitations previously brought forth in the disclosure. No new matter has been included. All new claims 27-32 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

Response to Rejection of the Specification under 35USC112

The applicant submits that the new specification describes the subject matter of the instant invention with sufficient clarity and detail to overcome the rejection thereof under 35USC112.

Regarding to Rejection of Claims 1-10 and 16-19 under 35USC102/35USC103

The Examiner rejected claims 1-10 and 16-19 as being anticipated by or in the alternative, as obvious over Hosada (US 6,608,006). Pursuant to 35 U.S.C. 102, “a person shall be entitled to a patent unless:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

In view of 35 U.S.C. 102(b), it is apparent that a person shall not be entitled to a patent when his or her invention was patent in this country more than one year prior to the date of the application for patent in the United States.

However, the Hosada patent and the instant invention are not the same invention according to the fact that the independent claim 27 of the instant invention does not read upon the Hosada patent. Apparently, Hosada fails to anticipate the distinctive features of the instant invention as follows:

(a) In claim 27, “a shoe lining comprising a foaming cushion layer sandwiched between an inner layer and a cover layer” is claimed for footwear, Hosada merely teaches a method for producing a foamed polyolefin composite sheet without any mention of any structure to form a shoe lining for footwear.

(b) In claim 27, "the foaming cushion layer is made by irradiation technology that polyolefin molecules are crosslinked by electron-beam irradiation" is claimed to have water repellant and air breathable properties, wherein Hosada merely teaches, in column 2, lines 17-21, the foamed composite sheet has high strength, improved water resistance, moisture resistance, thermal insulation, and chemical resistance without any mention of any foaming cushion layer having water repellant and air breathable properties. The Examiner alleges that the foamed composite sheet of Hosada is similar to the foaming cushion layer of the instant invention, the foaming cushion layer of the instant invention is made by irradiation technology to obtain the water repellant and air breathable properties in which the foamed composite sheet of Hosada merely has thermal insulation property.

(c) In claim 27, "the foaming cushion layer is made of a composition of low density polyethylene and foaming agent" is claimed, wherein Hosada merely teaches the foam comprises a polyolefin, blowing agent and cross-linking agent.

(d) In claim 27, "the inner layer and the cover layer are integrally attached to the outer and inner sides of the foaming cushion layer to form a lining sheet to be cut" is claimed for fitting to the footwear as an inner lining thereof, wherein Hosada is silent regarding the foamed layer is sandwiched with the linings in an integrally attaching manner.

(e) Hosada fails to teach the foaming cushion layer is made by the steps of: (a) palletizing... (b) extruding... (c) cross-linking... and (d) foaming... to form the inner lining of the footwear having water repellant and air breathable properties as claimed in claim 26. Hosada merely teach a process of producing a foamed sheet having thermal insulation property. The applicant respectfully submits that the foaming cushion layer is limited and defined by the manufacturing process thereof to obtain the water repellant and air breathable properties. In other words, the foamed sheet of Hosada is not equivalent to the foaming cushion layer of the instant invention.

(f) Hosada fails to teach and anticipate the foaming agent is azodicarbonamide and is combined with low density polyethylene through the irradiation technology as claimed in claim 27.

(g) Hosada fails to teach and anticipate the lining layer and the cover layer are integrally adhered to the outer and inner sides of the foaming cushion layer respectively as claimed in claims 28 and 29.

Accordingly, Hosada fails to anticipate the distinctive features (a) to (g) as claimed in the instant invention. Hosada is not a qualified prior art of the instant invention and should be removed from the prior art list of the instant invention.

Response to Rejection of Claims 11-14, 20-21, and 24-25 under 35USC103

The Examiner rejected claims 11-14, 20-21, and 24-25 over Hosada in view of Nakae (US 4,446,254). Pursuant to 35 U.S.C. 103:

“(a) A patent may not be obtained though the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and Hosada which is qualified as prior art of the instant invention under 35USC102(b) are obvious in view of Nakae at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

However, as recited above, Hosada merely teaches a foamed sheet has high strength, improved water resistance, moisture resistance, thermal insulation, and chemical resistance without any mention of any foaming cushion layer having water repellant and air breathable properties.

The applicant respectfully submits that in order to determine whether the differences between the subject matters sought to be patent as a whole of the instant invention and the primary prior art, Hosada, are obvious in view of the supplemental cited art, Nakae, we have to identify all the differences between the claims of the instant inventions and Hosada. Accordingly, the difference between Hosada and the instant invention as claimed in claims 27 to 32 is not limited to the disclosure of "foaming material", but includes the above distinctive features (a) to (g). The applicant further identifies the difference between the claims of the instant invention and Hosada as follows:

(h) Hosada fails to teach the foaming cushion layer further comprises pigment and additives including Zinc oxide and Zinc Stearate integrally mixing with the composition of said low density polyethylene and the foaming agent as claimed in claims 30 to 32 in addition to what is claimed in claim 27 as a whole.

Whether the claims 27 to 32 as amended of the instant invention are obvious depends on whether the above differences (a) to (h) between the instant invention and Hosada are obvious in view of Nakae at the time of the invention was made.

Furthermore, the applicant respectfully submits that when applying 35 USC 103, the following tenets of patent law must be adhered to:

- (a) The claimed invention must be considered as a whole;
- (b) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (c) The references must be viewed without the benefit of hindsight vision afforded by the claimed invention; and
- (d) Reasonable expectation of success is the standard with which obviousness is determined.

Also, "The mere fact that a reference could be modified to produce the patented invention would not make the modification obvious unless it is suggested by the prior art." Libbey-Owens-Ford v. BOC Group, 4 USPQ 2d 1097, 1103 (DCNJ 1987).

Nakae merely teaches zinc stearate and lead stearate are appropriate and exhibit a combination of effects of increasing the expansion ratio and decreasing the optimum irradiation dose necessary for providing the foams having a high degree of expansion without any suggestion of how such zinc stearate and lead stearate be possibly equipped in the foaming cushion layer which is made of a composition of low density polyethylene and foaming agent and is made by irradiation technology to have water repellant and air breathable properties.

“To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited art references for combination in the manner claimed... [T]he suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness...” *In re Gorman*, 933 F.2d 982, 986, 18 USPQ 2d 1885, 1888 (Fed. Cir. 1991).

Accordingly, the applicant believes that neither Hosada nor Nakae, separately or in combination, suggests or makes any mention whatsoever of the difference subject features (a) to (h) as claimed in the amended claims 27 to 32 of the instant invention.

Commercial Success

Attached hereto is a Rule 132 Declaration by the inventor or assignee, Frank Tien, of the present application.

Frank Tien currently makes and sells shoe lining embodying the subject matter of the '728 application's claim 27-32. This shoe lining is sold under the trademark Aquashield Bootie. Over 1,537,886 pairs of footwear containing the structure of the instant invention have been sold. Over 738,490 pairs of the instant invention were sold from May 01, 2004 to December 31, 2004. Over 658,848 pairs of the instant invention were sold in the whole year of 2005. Over 140,548 pairs of the instant invention were sold from January to June 2006.

The applicant believes that, an important reason for the commercial success of the shoe lining is its superior waterproof and air breathable characteristics, which has

been expressed in claims 27-32 of the '728 application. According to the applicant's knowledge no other commercially available utility lighter has achieved such standout characteristics as mentioned above.

The Rule 132 Declaration sets forth in detail evidence of the commercial success, which is a shoe lining embodying claims 27-32 made and sold by the applicant. Based on this evidence, which both rebuts the *prima facie* of obviousness and establishes an important secondary factor of non-obviousness, namely commercial success, the Examiner is requested to reconsider and withdraw the obviousness rejection made against claims 27-32.

Practically speaking, the instant invention as claimed in the newly drafted claims 27 to 32 contains structural features different to each of the cited arts. The instant invention is already successfully marketed in the United States. The volume of sale substantially proves that hundred and thousand of consumers satisfy with the structural features of the instant invention. Regardless of the structural features different from the cited arts is distinctive or obvious, if the instant invention fails to obtain a patent with claims for limited protection, everybody in this industry (including the applicants of the cited arts) can simply copy the structural features of the instant invention without the need of investing any research and development cost but to compete with the applicant in lower product cost in the applicant's market. It is not only an unfair competition but also violates the spirit of encouraging invention and technology development of the patent law. Accordingly, a secondary factor of commercial success for non-obviousness is established and the Examiner is requested to reconsider and withdraw the obviousness rejection made against claims 27-32.

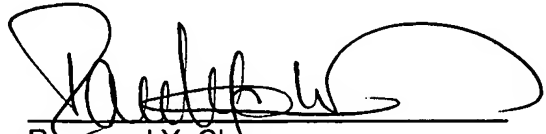
The Cited but Non-Applied References

The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the objection are requested. Allowance of claims 27-32 at an early date is solicited.

Should the Examiner believe that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

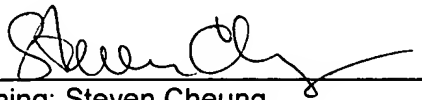


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CERTIFICATE OF MAILING

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